

REMARKS

The allowance of claims 1-7 and 16-31 is acknowledged. New claims 32-35 are added to claim the invention in alternative language. All claims are thought to be allowable over the cited art.

The rejections of the claims under §102 and §103 are respectfully traversed. As to the §102 rejection of claim 8, the Office Action does not show that all the limitations are taught by "Beebe" (US patent no. 6,021,513 to Beebe et al.). For example, the cited teachings of Beebe show a programmable gate array (FIG. 9). There is no apparent embedded core device along with Beebe's gate array. The asserted programmable logic units of Beebe appear to be part of Beebe's gate array, not an embedded core device as understood by those skilled in the art. Thus, Beebe would have no apparent need for the claimed gasket and isolation circuitry. Therefore, the Office Action has not shown that claim 8 is anticipated by Beebe.

The Office Action does not establish a *prima facie* case of obviousness of claims 9-15 under 35 USC §103(a) over Beebe in view of patent no. 5,675,589 to Yee ("Yee"). The Office Action does not show that all the limitations are suggested by the combination. For example, the limitations of base claim 8 are not shown by Beebe as explained above. Furthermore, the limitations in claims 9-15 further refine the limitations of and related to interfacing between the FPGA fabric and the embedded core device as set forth in claim 8. Having failed to show any teaching of an embedded core device, the Office Action necessarily fails to show a suggestion of the claimed interface between the FGPA fabric and the embedded device.

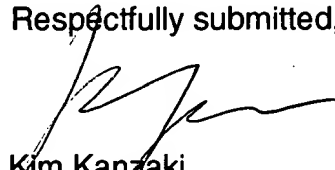
The alleged motivation for combining Yee with Beebe is conclusory and improper. The alleged motivation states that the combination would have been obvious "because it would improve test efficiency and effectiveness." However, the allegation is made without any supporting evidence. For example, there is no evidence set forth to indicate that Beebe's testing approach is less efficient than would be the efficiency of the asserted combination. Furthermore, no evidence is provided that indicates that Beebe's testing approach is inherently inefficient. Therefore, the Office Action fails to provide a proper motivation for combining Yee with Beebe.

The rejection of claims 9-15 over the Beebe-Yee combination should be withdrawn because the Office Action fails to show all the limitations are suggested by the combination, fails to provide a proper motivation for combining the references, and fails to show that the combination could be made with a reasonable likelihood of success.

CONCLUSION

No new matter has been introduced by any of the above amendments. All claims are now in condition for allowance, and accordingly, a Notice of Allowance is respectfully requested. If there are any questions, the undersigned may be contacted at the telephone number listed below.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on December 8, 2004.

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